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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,387	03/09/2004	Cheng T. Horng	HT03-009	1901

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EXAMINER

KLIMOWICZ, WILLIAM JOSEPH

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/796,387

Applicant(s)

HORNG ET AL.

Examiner

William J. Klimowicz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 34-55 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-33 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group II (claims 1-33, drawn to a process) and the additional election of Specie I (corresponding to Figure 1, and the process of the invention associated therewith) in the reply filed on July 17, 2006 is acknowledged. The traversal as it pertains to the election of Group II (process claims) versus Group I (product claims) is on the ground(s) that:

product, or (2) the product as claimed can be made by another and materially different process (M.P.E.P. 806.05(f)). However, upon reading the process Claims against the product Claims one can readily see that the process Claims are directed to a method of "fabricating a CPP spin valve structure", and that the product claims are directed to "a CPP spin valve structure", and that it is necessary to obtain claims in both the process and product claim language. The process claims necessarily use the product and vice versa. The field of search must necessarily cover both the process class/subclass 204/192.2 and product class/subclass 360/324.1, in addition to other related classes and subclasses, to provide a complete and adequate search. The fields of search for Groups I and II are clearly and necessarily co-extensive. The Examiner's suggestion that "in the instant case the product could be made by a process not requiring the fabrication steps as articulated in the method claims, including the use of, inter alia, a chemical etch, a particular pressure of oxygen not specifically set forth in identifying Group I, etc." is speculative and has nothing to do with the Claims as presented in this patent application.

See page 2-3 of the Response filed on July 17, 20006. This is not found persuasive because the Examiner maintains that the product and process inventions are distinct for the reasons given in the previous restriction requirement, i.e., that the Group I claims 34-55, which are drawn to a CPP spine valve structure, classified in class 360, subclass 324.1, and the Group II claims, 1-33, drawn to a method of fabricating a CPP spin valve structure, classified in class 204,

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subclass 192.2 are *a priori* distinct, each from the other since Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (**MPEP § 806.05(f)**). In the instant case the product could be made by a process not requiring the fabrication steps as articulated in the method claims, including but not limited to: vacuum deposition *and/or* plating deposition *and/or* chemical vapor deposition *and/or* plasma enhanced chemical vapor deposition *and/or* physical vapor deposition *and/or* reactive ion etching *and/or* wet etching *and/or* chemical mechanical polishing *and/or* surface abrading *and/or* thermal ablation *and/or* non-sequential method steps which are not promulgated in the process Grouping, *supra*, *and/or* other well known techniques in the art used in manufacturing disk drives and related components used therein, including magnetic heads.

Moreover, because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Moreover still, the Examiner maintains that all that is required to be shown to demonstrate a materially different process or product is “a viable alternative process or product,” and that “[a]llegations of different process or products need not be documented.” See **MPEP 806.05(f)**. The Examiner maintains that the materially different process to make the claimed product of the Applicant, is indeed a viable alternative.

As it pertains to the restriction between the product and process claims, the following should be noted. Where Applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with **37 CFR 1.104**. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of **35 U.S.C. 101, 102, 103 and 112**. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See **MPEP § 821.04(b)**. Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of **35 U.S.C. 121** does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See **MPEP § 804.01**.

Moreover still, it is noted the process claims are not commensurate in scope with the product claims. That is, the process claim(s), as presently drafted, fail to depend from or otherwise include *all* the limitations of the product claim(s).

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Thus, the Examiner has clearly shown that the instant invention can be made by another materially different process(es), and that these delineated processes are indeed a “viable alternative.” In **MPEP 806.05(f)**, which expressly pertains to “Process of Making and Product Made” restriction criteria, it unambiguously states that all that is required to be shown for material difference is “a viable alternative process or product,” and that “[a]llegations of different process or products need not be documented.” See **MPEP § 806.05(f)** for further details.

Because these inventions are **independent or distinct** for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is **PROPER**.

More specifically, as set forth in **MPEP § 803**:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (**MPEP § 806.04 - § 806.04(i)**) *or* distinct (**MPEP § 806.05 - § 806.05(i)**). [Emphasis in bold italics added].

Moreover as set forth in **MPEP § 802.01**, the meaning of independent “and” distinct within the context of Patent Office restriction policy and practice is articulated as follows:

**35 U.S.C. 121** quoted in the preceding section states that the Commissioner may require restriction if two or more “independent and distinct” inventions are claimed in one application. In **37 CFR 1.141**, the statement is made that two or more “independent and distinct inventions” may not be claimed in one application.

This raises the question of the subjects as between which the Commissioner may require restriction. This, in turn, depends on the construction of the expression “independent and distinct” inventions.

“Independent,” of course, means not dependent. If “distinct” means the same thing, then its use in the statute and in the rule is redundant. If “distinct” means

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something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that **35 U.S.C. 121**: “enacts as law existing practice with respect to division, at the same time introducing a number of changes.”

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term “independent” as already pointed out, means not dependent. A large number of subjects between which, prior to the **1952 Act**, division had been proper, are dependent subjects, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section **121** of the **1952 Act** were intended to direct the Commissioner never to approve division between dependent inventions, the word “independent” would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., the examples used for purpose of illustration above. Such was clearly not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term “distinct” with the term “independent,” indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact, “distinct” inventions, even though dependent.

Thus, clearly, the restriction is proper if the Examiner shows that the inventions are distinct **or** independent, but not necessarily both independent *and* distinct.

The Examiner *additionally* maintains that each identified Product and Process Grouping, as articulated in the Requirement for Restriction, *supra*, would impose other grave, *serious burdens* upon the Examiner. Moreover, in accordance with **37 CFR 1.104**, to the nature of each distinctly grouped Product and Process Grouping, the Examiner must make a thorough study

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thereof and a thorough investigation of the available prior art relating to the claimed subject matter of each distinctly identified Product and Process Grouping. The examination for each distinct Product and Process Grouping must be complete with respect both to compliance of the application with the applicable statutes and rules and to the patentability of the invention as claimed, in addition to matters of form, including **Title 35** to the **United States Code**, sections **101, 102, 103** and **112**, to each distinctly Product and Process Grouping.

Moreover, each separately Product and Process Grouping must be thoroughly searched, including, but not limited to, various searching fields, inclusive of differing text search strategies and/or queries, determination of anticipation, if any, of uncovered prior art, potential application of the Graham factual inquiries to each distinct invention to review for any indicia of possible obviousness, etc.

Moreover still, as has been held, if there is an express admission that the claimed inventions would have been obvious over each other within the meaning of **35 U.S.C. § 103**, restriction should not be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978).

***There is nothing on record, at present, to show that the distinctly grouped inventions are obvious variants***

The traversal as it pertains to the election of Species I versus Species II is on the ground(s) that:

the increased costs applicant would be forced to bear if the two species are separately examined. Furthermore, the field of search must necessarily cover both species, in addition to other related Classes and subclasses, to provide a complete and adequate search.



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*Id.* at p. 4. After a search for the invention of Species and a reconsideration, the Examiner has agreed to withdraw the Election of Species Restriction. The Examiner has determined that the claimed Species I and II are not patentably distinct.

To summarize, the Examiner maintains the restriction between the Product and Process claims, with the Applicant electing Process claims 1-33, and has expressly withdrawn the Election of Species restriction requirement.

The requirement as it pertains to the Product and Process Groupings of distinct inventions is still deemed proper and is therefore made **FINAL**.

#### ***Claim Status***

Claims 1-55 are currently pending.

Claims 1-33 have been considered on the merits, and have been indicated as containing allowable subject matter.

Claims 34-55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Invention/specie, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on July 17, 2006.

This application is in condition for allowance except for the presence of claims 34-55 directed to an invention non-elected with traverse in the reply filed on July 17, 2006. Applicant is given ONE MONTH or THIRTY DAYS from the date of this letter, whichever is longer, to

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cancel the noted claims or take other appropriate action (37 CFR 1.144). Failure to take action during this period will be treated as authorization to cancel the noted claims by Examiner's Amendment and pass the case to issue. Extensions of time under 37 CFR 1.136(a) will not be permitted since this application will be passed to issue.

The prosecution of this case is closed except for consideration of the above matter.

### ***Conclusion***

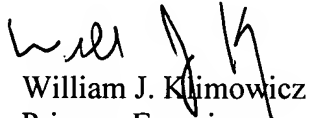
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (571) 272-7577. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Thi Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
William J. Klimowicz  
Primary Examiner  
Art Unit 2627

WJK